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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,038	03/03/2004	Melissa K. Rath	ATMI-668	4823
25559	7590	10/24/2005	EXAMINER	
ATMI, INC.			LE, HOA VAN	
7 COMMERCE DRIVE			ART UNIT	
DANBURY, CT 06810			PAPER NUMBER	

1752

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/792,038

Applicant(s)

RATH ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 23-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-52 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12 September 2005</u> . | 6) <input type="checkbox"/> Other: _____ |

This is in response to Papers filed on 22 August 2005.

I. Claims 1-2, 5, 8-9, 11-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-17 of copending Application No. 10/389,214 as amended on 21 August 2005. Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain the same or obviously chemical ingredients and the same or substantially the same amounts. The instant claims are related to composition. Accordingly, it patentability is mainly on the chemical ingredient and its amount. The language "is useful for..." has been considered as an intended use in the claimed composition. The record show that the same or substantially the same composition is also has another use as disclosed, taught and suggest in the related Application No. 10/389,214 as amended on 21 August 2005 and as urged by applicants. Therefore, the intended use has and is given a little value for the patentability of the composition claims since the claimed composition has another use. It is submitted that the claimed composition, per se, can be traded, exchanged or commerced by itself. Applicants may show or provide an evidence to the

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contrary for the record for the patentability of the composition claims.

However, the intended use is given full values in a method or process claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

II. Applicant's arguments filed 22 August 2005 have been fully considered but they are not persuasive.

Applicants urge that the double patenting rejection is overcome since claimed composition contains an intended use.

The instant claims are related to composition. Accordingly, it patentability is mainly on the chemical ingredient and its amount. The language "is useful for..." has been considered as an intended use in the claimed composition. The record show that the same or substantially the same composition is also has another use as disclosed, taught and suggest in the related Application No. 10/389,214 as amended on 21 August 2005 and as urged by applicants. Therefore, the intended use has and is given a little value for the patentability of the composition claims since the claimed composition has another use. It is submitted that the claimed composition, per se, can be traded, exchanged or commerced by itself. Applicants may

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show or provide an evidence to the contrary for the record for the patentability of the composition claims. However, the intended use is given full values in a method or process claims.

III. It is a record that Application Serial No. 10/389,214 has its Publication No. 2004/0180300 being applied as followed:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 5, 8-9 and 11-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minsek et al (2004/0180300).

Minsek et al disclose and teach a cleaning composition comprising a sufficient amount of a strong base, a sufficient amount of an oxidant, a sufficient amount of a chelator, a sufficient amount of a co-solvent, a sufficient amount of a surfactant and a sufficient amount of water. Please see the whole disclosure of the applied reference, especially at paragraphs [0009], [0010], [0013], [0015], [0017], [0018] to [0021], [0023] to [0025].

The instant claims are related to composition. Accordingly, it patentability is mainly on the chemical ingredient and its amount. The

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language "is useful for..." has been considered as an intended use in the claimed composition. The record show that the same or substantially the same composition is also has another use as disclosed, taught and suggest in the related Application No. 10/389,214 as amended on 21 August 2005 and as urged by applicants. Therefore, the intended use has and is given a little value for the patentability of the composition claims since the claimed composition has another use. It is submitted that the claimed composition, per se, can be traded, exchanged or commerced by itself. Applicants may show or provide an evidence to the contrary for the record for the patentability of the composition claims. However, the intended use is given full values in a method or process claims.

Since Minsek et al are reasonably disclosed, taught and suggested the claimed embodiments, the above claims are found to be rendered prima facie obvious by Minsek et al.

IV. Applicant's arguments filed 22 August 2005 have been fully considered but they are not persuasive.

Applicants urge that the double patenting rejection is overcome since claimed composition contains an intended use.

The instant claims are related to composition. Accordingly, it patentability is mainly on the chemical ingredient and its amount. The language “is useful for...” has been considered as an intended use in the claimed composition. The record show that the same or substantially the same composition is also has another use as disclosed, taught and suggest in the related Application No. 10/389,214 as amended on 21 August 2005 and as urged by applicants. Therefore, the intended use has and is given a little value for the patentability of the composition claims since the claimed composition has another use. It is submitted that the claimed composition, per se, can be traded, exchanged or commerced by itself. Applicants may show or provide an evidence to the contrary for the record for the patentability of the composition claims. However, the intended use is given full values in a method or process claims.

V. However, applicants urge that the applied Minsek et al (2004/0180300) should be later applied to the non-elected species “(b)” only. It is reasonable. Accordingly, Applicants are not required to respond to paragraphs “III” and “IV” above but may optionally respond them to speed up the prosecution.

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VI. Applicants elect the species of the combination of “a quaternary ammonium base in combination with at least one of alkali and alkaline earth base” species and its subspecies of “Formulation G” in claims 1-7 and 10 as stated on the record by applicants have been considered and searched.

Others non-elected species and subspecies have not been considered, searched or examined until all of the elected and applied species are overcome. Accordingly, claims 8-9 and 11-23 are withdrawn from consideration of a search as being non-elected species and subspecies.

VII. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carati et al (5,908,968).

Carati et al disclose, teach and suggest a clear alkaline aqueous composition comprising a sufficient amount of a quaternary ammonium base, a sufficient amount of an alkali metal salt base, an additive and a sufficient amount of water. Please see col.6:30-31. The instant claims are related to composition. Accordingly, its patentability is mainly on the chemical ingredient and its amount. The language “is useful for...” has been considered as an intended use in the claimed composition. The record shows that the same or substantially the same composition is also has another use

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as urged by applicants. Therefore, the intended use has and is given a little value for the patentability of the composition claims since the claimed composition has another use. It is submitted that the claimed composition, per se, can be traded, exchanged or commerced by itself. Applicants may show or provide an evidence to the contrary for the record for the patentability of the composition claims. However, the intended use is given full values in a method or process claims.

Since Carati et al is reasonably disclosed, taught and suggested the claimed embodiments, the above claims are found to be rendered prima facie obvious by Carati et al.

VIII. Applicant's arguments filed 22 August 2005 have been fully considered but they are not persuasive.

Applicants urge that the claimed composition is overcome the applied Carati et al since claimed composition contains an intended use.

The instant claims are related to composition. Accordingly, it patentability is mainly on the chemical ingredient and its amount. The language "is useful for..." has been considered as an intended use in the claimed composition. The record show that the same or substantially the same composition is also has another use as disclosed, taught and suggest in

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Carati et al and as urged by applicants. Therefore, the intended use has and is given a little value for the patentability of the composition claims since the claimed composition has another use. It is submitted that the claimed composition, per se, can be traded, exchanged or commerced by itself. Applicants may show or provide an evidence to the contrary for the record for the patentability of the composition claims. However, the intended use is given full values in a method or process claims.

IX. Claims 1-5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al (6,572,743).

Miller et al disclose and teach a clear alkaline aqueous composition comprising a sufficient amount of a quaternary ammonium base, a sufficient amount of potassium hydroxide, an additive and a sufficient amount of water. Please see col.13:8-16. The instant claims are related to composition. Accordingly, its patentability is mainly on the chemical ingredient and its amount. The language "is useful for..." has been considered as an intended use in the claimed composition. The record shows that the same or substantially the same composition is also has another use as urged by applicants. Therefore, the intended use has and is given a little value for the patentability of the composition claims since the claimed composition has

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another use. It is submitted that the claimed composition, per se, can be traded, exchanged or commerced by itself. Applicants may show or provide an evidence to the contrary for the record for the patentability of the composition claims. However, the intended use is given full values in a method or process claims.

Since Miller et al is reasonably disclosed, taught and suggested the claimed embodiments, the above claims are found to be rendered prima facie obvious by Miller et al.

X. Applicant's arguments filed 22 August 2005 have been fully considered but they are not persuasive.

Applicants urge that the claimed composition is overcome the applied Miller et al since claimed composition contains an intended use.

The instant claims are related to composition. Accordingly, it patentability is mainly on the chemical ingredient and its amount. The language "is useful for..." has been considered as an intended use in the claimed composition. The record show that the same or substantially the same composition is also has another use as disclosed, taught and suggest in Miller et al and as urged by applicants. Therefore, the intended use has and is given a little value for the patentability of the composition claims since the

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claimed composition has another use. It is submitted that the claimed composition, per se, can be traded, exchanged or commerced by itself.

Applicants may show or provide an evidence to the contrary for the record for the patentability of the composition claims. However, the intended use is given full values in a method or process claims.

XI. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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XII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le

18 October 2005

Hoa V. Le
Primary Examiner
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